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09/810,945	03/15/2001	Michael Goeller	P-11400US	7240

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EXAMINER

LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/810,945

Applicant(s)

GOELLER ET AL.

Examiner

JENNIFER LIVERSEEDGE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-54 is/are pending in the application.
- 4a) Of the above claim(s) 52-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for continued examination of Application 09/810,945 filed on June 24, 2008, and response to an Election/Restriction requirement filed on August 29, 2008.

The amendment contains elected new claims: 34-51.

Claims 1-33 have been canceled.

Claims 52-54 have been withdrawn (not indicated in listing of claims but so indicated in response).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 34-37, 39, 41-46, 48 and 50-51 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,647,376 B1 (further referred to as Farrar), and further in view of US Patent 7,356,502 B1 to LaBadie et al. (further referred to as LaBadie).

Regarding claim 34, Farrar discloses a system for conducting a commercial transaction using checking information comprising:

An input receiving device operable to receive transaction information including checking account information of a paper check and a sales amount for a purchase transaction, the checking account information including a transit routing number (TRN) (Figure 2; column 4, lines 7-27; column 6, lines 42-49; column 7, lines 30-40; column 8, line 60 – column 9, line 5; column 14, lines 11-59);

A host computer arranged to receive the transaction information from the input receiving device (Figures 1-2; column 4, lines 7-27; column 6, lines 50-55; column 14, lines 11-59);

A switch computer connected to the host computer and a plurality of participating drawee banks (Figures 1-2; column 6, lines 50-67; column 14, lines 11-59), the switch computer being operable to:

Receive a service request message containing the transaction information and a request to perform a conversion operation (Figures 1-2, 5; column 4, lines 7-27; column 6, lines 50-55; column 7, lines 54-56; column 8, lines 59-67; column 14, lines 11-59);

Farrar does not disclose where the switch computer is operable to:

Perform an exclusion check on the received service request message based on a comparison of the TRN contained in the service request message against a list of excluded transit routing numbers; send to the host computer an indicator indicating that the authorization for the conversion request is denied without forwarding the service request message to a drawee bank of the paper check if the performed exclusion check determines that the TRN is present in the list of excluded transit routing numbers; and send the received service request message to a selected one of the plurality of drawee banks with corresponds to the TRN is the performed exclusion check determines that the TRN is not present in the list of excluded transit routing numbers.

However, Farrar discloses where the host computer (the merchant processor) is operable to:

Perform an exclusion check on the received service request message based on a comparison of the TRN contained in the service request message against a list of excluded transit routing numbers (Figure 5; column 4, lines 15-18; column 9, line 1-17; column 14, lines 11-59); and

Send the received service request message to a selected one of the plurality of drawee banks with corresponds to the TRN is the performed exclusion check determines that the TRN is not present in the list of excluded transit routing numbers (Figure 5; column 9, lines 1-17; column 14, lines 11-59).

Farrar discloses that the merchant processor is connected to both a point of sale input device and an EFT switch such that received transaction data can be obtained and by using the TRN of the check, determine if the TRN is associated with a participating or not, such that if the TRN indicates a participating bank the data can be sent to the bank through the switch. It is obvious from Farrar that the receipt of transaction and TRN data is occurring and that a determination as to whether the transaction data should be sent along to a drawee bank or not is being made. If the check of the TRN indicates the bank is participant, the data is sent. If the check of the TRN indicates that the bank is not a participant, the data is not sent.

Farrar does not disclose sending an indicator indicating that the authorization for the conversion request is denied. However, LaBadie discloses sending an indicator indicating that the authorization for the conversion request is denied (column 2, lines 18-28; column 5, lines 40-53; column 6, lines 22-29 and lines 56-61). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the seeking of conversion based on the determination of TRN status as disclosed by Farrar to adapt the indication of a denied conversion request as disclosed by LaBadie. The motivation would be that when a request for a transaction is submitted, the requestor generally expects either for the request to be acted upon, for the request to be denied, or for some alternative to be offered.

Regarding claim 43, Farrar discloses a method of processing a paper check transaction occurring at a point of sale, the method comprising:

At a host computer:

Receiving transaction information including checking account information of a paper check and a sales amount for a purchase transaction, the checking account information including a transit routing number (TRN) (Figure 2; column 4, lines 7-27; column 6, lines 42-49; column 7, lines 30-40; column 8, line 60 – column 9, line 5; column 14, lines 11-59);

Assembling a service request message including the transaction information and a request to perform a conversion operation (Figure 5; column 4, lines 7-43; column 6, lines 42-67; column 8, line 60 – column 9, line 17; column 14, lines 11-59);

Transmitting the service request message to a switch computer (Figures 1, 5; column 8, line 57 – column 9, line 17; column 14, lines 11-59); and at the switch computer:

Receiving the transmitted service request message from the host computer (Figures 1, 5; column 8, line 57 – column 9, line 17; column 14, lines 11-59);

Sending a response received from the selected drawee bank to the host computer (Figures 2, 5; column 7, lines 12-15; column 9, lines 23-27; column 15, lines 10-18).

Farrar does not disclose where the switch computer is operable to:

Perform an exclusion check on the received service request message based on a comparison of the TRN contained in the service request message against a list of excluded transit routing numbers; send to the host computer an indicator indicating that the authorization for the conversion request is denied without forwarding the service request message to a drawee bank of the paper check if the performed exclusion check determines that the TRN is present in the list of excluded transit routing numbers; and send the received service request message to a selected one of the plurality of drawee banks with corresponds to the TRN is the performed exclusion check determines that the TRN is not present in the list of excluded transit routing numbers.

However, Farrar discloses where the host computer (the merchant processor) is operable to:

Perform an exclusion check on the received service request message based on a comparison of the TRN contained in the service request message against a list of excluded transit routing numbers (Figure 5; column 4, lines 15-18; column 9, line 1-17; column 14, lines 11-59); and

Send the received service request message to a selected one of the plurality of drawee banks with corresponds to the TRN is the performed exclusion check determines that the TRN is not present in the list of excluded transit routing numbers (Figure 5; column 9, lines 1-17; column 14, lines 11-59).

Farrar discloses that the merchant processor is connected to both a point of sale input device and an EFT switch such that received transaction data can be obtained and by using the TRN of the check, determine if the TRN is associated with a participating or not, such that if the TRN indicates a participating bank the data can be sent to the bank through the switch. It is obvious from Farrar that the receipt of transaction and TRN data is occurring and that a determination as to whether the transaction data should be sent along to a drawee bank or not is being made. If the check of the TRN indicates the bank is participant, the data is sent. If the check of the TRN indicates that the bank is not a participant, the data is not sent.

Farrar does not disclose sending an indicator indicating that the authorization for the conversion request is denied. However, LaBadie discloses sending an indicator indicating that the authorization for the conversion request is denied (column 2, lines 18-28; column 5, lines 40-53; column 6, lines 22-29 and lines 56-61). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the seeking of conversion based on the determination of TRN status as disclosed by Farrar to adapt the indication of a denied conversion request as disclosed by LaBadie. The motivation would be that when a request for a transaction is submitted, the requestor generally expects either for the request to be acted upon, for the request to be denied, or for some alternative to be offered.

Regarding claims 35 and 44, Farrar discloses wherein the input receiving device includes a magnetic ink character recognition device operable to receive the paper

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check, the paper check no being used as a negotiable instrument and being returned to the customer (Figure 2; column 6, lines 38-48; column 8, lines 60-65; column 12, lines 29-31; column 14, lines 11-26; column 15, lines 10-18).

Regarding claims 36 and 45, Farrar discloses wherein the input device includes a keyboard (Figure 2; column 7, lines 28-40).

Regarding claims 37 and 46, Farrar discloses wherein the conversion operation comprises one of conversion only, conversion with verification and conversion with guarantee (at least column 1, lines 41-48; column 2, lines 17-25).

Regarding claims 39 and 48, Farrar discloses wherein the input device further includes a point of sale terminal into which the purchase amount may be entered (Figure 2; column 7, lines 28-40).

Regarding claims 41 and 50, Farrar discloses wherein the service request message includes a unique transaction identifier that allows related transactions to be associated in a set (column 9, lines 1-16; column 14, lines 33-53 where the request message includes the MICR data which includes the TRN which allows the related transactions for the TRN to be associated).

Regarding claims 42 and 51, Farrar discloses wherein the host computer and the switch computer are connected via a telecommunication network (column 7, lines 23-27).

Claims 38, 40, 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrar and LaBadie, and further in view of US Patent 5,679,940 to Templeton (further referred to as Templeton).

Regarding claims 38 and 47, neither Farrar nor LaBadie disclose wherein the transaction information includes one or more separators and the input receiving device translates the one or more separators into alphanumeric characters. Farrar does disclose that messages are created and sent in standard message protocol as defined by ISO 8583 format (column 16, lines 20-45). Further, Templeton discloses wherein the transaction information includes one or more separators and the input receiving device translates the one or more separators into alphanumeric characters (column 23, line 27 – column 24, line 27). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the use of standard ISO 8583 message format to adapt the use of separators and alphanumeric characters as disclosed by Templeton, the motivation being to create a standard message which can be sent and received by participating processing organizations.

Regarding claim 40 and 49, neither Farrar nor LaBadie discloses wherein the service request message includes a settlement code indicating how the settlement will occur. However, Templeton discloses wherein the service request message includes a settlement code indicating how the settlement will occur (column 12, line 66 – column 13, line 17; column 25, line 45 – column 26, line 20). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the sending of settlement codes for conversion, conversion with verification or conversion with guarantee as disclosed by the combination of Farrar and LaBadie to adapt the use of a code to indicate how settlement will occur as disclosed by Templeton, the motivation being to provide a single data packet that includes data necessary for processing the request message.

Response to Arguments

The claims as submitted in the present amendment are new claims as submitted with an RCE.

Applicant argues that the prior art of record fails to disclose a switch computer operable to perform an exclusion check on a received service request message based on a comparison of the TRN in the service request message to a list of TRNS and then not route the service request message to a drawee bank based on the comparison.

However, examiner points to the disclosure of Farrar which performs these very steps. Farrar discloses the obtaining of TRN data from the MICR line of a check. The TRN number is checked against of list of TRNs associated with participating banks. If

the TRN is not found on the list of participating banks, the request is not sent to a drawee bank. The difference then is that Farrar does not disclose returning a decline message but rather in Farrar an authorization decision is then made by consulting other known databases in the art. However, as detailed LaBadie discloses sending a decline message back to the merchant without sending a response packet to a drawee bank.

It is noted a comparison of the drawings of Farrar and Templeton both disclose the use of a POS input device, a host or merchant processor, and EFT switch, and drawee banks. In each case, TRN data is obtained at a POS device by means of a check being run through a MICR reader and the check returned to the customer. The TRN data obtained from the check at the POS is then compared to a list of TRN data to determine if the TRN data is found on the list or not. Based on the determination, transaction data is either sent to a drawee bank or not.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Examiner, Art Unit 3692